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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,335	07/08/2003	Torsten Otto	22599	8755

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EXAMINER

TRINH, MINH N

ART UNIT PAPER NUMBER

3729

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n N .

10/615,335

Applicant(s)

OTTO ET AL.

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-8) in the reply filed on 10/27/04 is acknowledged. The traversal is on the ground(s) that the examiner has not established a prima facie case of serious burden of examination of the inventions of Groups I and II together. This is not found persuasive because the examiner has, established a prima facie case having shown in prior Office action, that the invention of group I has a separate classification (class 29, subclass 828) from the inventions of Group II (Class 439, subclass 92). Moreover, the inventions of Group I and II each have a separate status in the art and clearly have a separate field of search. In accordance with MPEP §803, the examiner has demonstrated that the inventions of Group I and II are each independent or distinct as claimed (as indicated in prior Office action, paragraph 1). Applicants' reasons therefore are not persuasive, because examination of the independent inventions herein would present a serious burden to the Examiner in as much as the searches are not coextensive and the art is quite prolific. Accordingly, the requirement is repeated and **MADE FINAL**.

2. Claims 9-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/27/04.

An Office action on the merits of claims 1-8 as follows:

***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The abstract of the invention should have been revised to reflect the method invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:
  - a) "said layer" (claim 2, line 5) lacks proper antecedent basis.
  - b) "the incorporation of metal fibers" (claim 7, line 2), "the plastic " (claim 7, line 4) lack proper antecedent bases.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gianngrasso (6,126,119).

Gianngrasso discloses a method of grounding a metal tube surrounded by an electrically nonconductive plastic layer to a metal part of the present invention including steps of: providing a clip or clamp 18 at least in part composed of a plastic which has been made electrically conductive and having a penetrating portion (see Fig. 2A, depicts plurality ribs or penetrating portions associated therefrom), applying said clip to the metal tube P surrounded by the electrically nonconductive plastic layer I and pressing said penetrating portion through said plastic layer into direct electrically conducting contact with the metal tube (see Fig. 1A), and electrically connecting said clip to said metal part C or S (see Fig. 2A, and the discussion at col. 3, lines 30-35). Gianngrasso is silent about a step of welding said clip to said plastic layer. However, it is inherent that by compressing the clip to said plastic layer would result a welding between the clip and the plastic layer. Furthermore, Gianngrasso discloses the clip being butted to the plastic layer by means of compression welding (see the discussion at col. 3, lines 14-27). It is noted that reference C or S of the Gianngrasso reference represented the broadly claimed "a metal part " of the present application

9. Claims 2-8 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Gianngrasso (6,126,119) in view of Benoit et al (6,669,150).

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As applied to claim 2, Gianngrasso does not teach the metal part is being a chassis of a motor vehicle. Benoit et al disclose the metal part is a chassis of a vehicle (see the discussion at col. 7, lines 35-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the Benoit 's teachings of the metal part is being a chassis of a vehicle into the method invention of Gianngrasso in order to facilitate the fabrication process including connectively attached the clip to a connecting sites in an effectively manner.

As applied to claim 3-6, it would have been an obvious matter of design choice to choose any desired welding techniques including pressure, ultrasonic, vibration or induction, welding, etc, since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the welding by compressing to join the clip and the plastic layer together as shown in the prior art reference (see Figs. 1-6 of Benoit et al). Further, welding by ultrasonic, vibration or induction are known to the art, one having ordinary skill in the art would know to use the available above welding onto the modified invention of Gianngrasso for various known benefits including connectively welded the clip to the plastic layer in an effectively manner.

As applied to claim 7-8, noting Benoit et al disclose the associated material including elastomeric material such as nylon, rubber, or other forms of composite materials, which represent the incorporation of metal fibers and glass fibers as recited in the above claims.

***Conclusion***

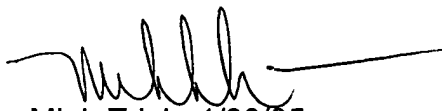
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mt

  
Minh Trinh 1/30/05  
Primary Examiner